



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/795,997	02/05/97	MONAHAN	10990007XR

ROBERT M SULLIVAN
IBM CORPORATION
INTELLECTUAL PROPERTY LAW
9000 S RITA ROAD
TUCSON AZ 85744

LM02/0728

EXAMINER
CHOCLES, J

ART UNIT	PAPER NUMBER
2771	

DATE MAILED: 07/28/88

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/795,997

Applicant(s)
Monahan et al.

Examiner
Jack M. Choules

Group Art Unit
2771



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3, 5, 7, and 9 is/are rejected.

☒ Claim(s) 2, 4, 6, and 8 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2771

DETAILED ACTION

1. Claims 1-9 are presented for examination. The examiner wishes to thank the applicants representatives for responsiveness to the requests made in the interviews. The Examiner regrets having made a verbal indication of allow ability as a particularly relevant prior art has come to the examiners attention which motivates a rejection. Applicants are encouraged to contact examiner if they feel doing so will expedite prosecution.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2771

4. Claims 1, 3, 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. [hereafter Martin] Patent No. 5,214,768.

5. As to claims 1, 3, 5, and 9, Martin disclosed the invention substantially as claimed including a data processing system ['DP'] comprising "an automated storage library" (col. 4, lines 25-39) [Note: volumes are not specifically addressed, however, the current application defines a volume as a side of a disk (application page 5 lines 63-67) or in the case of a one side disk a disk, in the system of Martin the library uses a tape drive there a tape or a track on the tape would be the analogous to the disk or side of the disk and thus volumes.]; "a controller" (col 3, lines 45-col.4, lines 7 and col. 6, lines 25-65), "controller receiving" (col. 6, lines 25-27) [Note: request identifying selected file is not specifically detailed however it is considered inherent that the file to be addressed must be identified in the request, also the request identifying the automatic storage libraries would be inherent or the request would not be displaced to the storage library.] , "controller determining" (col. 3, lines 59-64), "controller allocating" (col 3, lines 64-col.4, lines 7); and "automated means transferring" (col. 4, lines 25-52 and col. 21, line 66-col. 22, line 22);

6. Martin does not detail identifying "a specified volume" or "host processor unaware" and the controller functions are contained in the controller and interface subsystem of Martin. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to identify "a specified volume" in the request from the host because different data

Art Unit: 2771

storage media may have files which have the same name especially and providing the volume identification would differentiate between system improving the versatility of the DP system. It would have been inherent or at least obvious to one of ordinary skill in the DP art at the time of the applicant's invention to maintain the host processor unaware as Martin does teach that the control system handles the allocation of library resources such as drives (col. 5, line 63-col. 6, line 15) further it would have been obvious to maintain the host processor unaware because not informing each host processor which drive was reading the media would save on communication time and bandwidth improving the DP system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the control subsystem with the interface subsystems, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Allowable Subject Matter

7. Claim 2, 4, 6, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The specific format of the request "with a specification of a storage drive coupled to the host

Art Unit: 2771

processor replaced with a specification of the library, and a specification of a subdirectory in a storage drive coupled to the host processor replaced with a specification of a volume in the library" is not taught or suggested in the prior art of record in a system similar to the claimed invention. This element in combination with the other elements of the claimed invention renders the invention novel and non-obvious over the art of record.

9. Since allowable subject matter has been indicated, formal drawings have been transferred from patent number 5,388,260 as requested by the applicant.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All the prior art cited in the parent patent is also made of record in the current application.

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

Art Unit: 2771

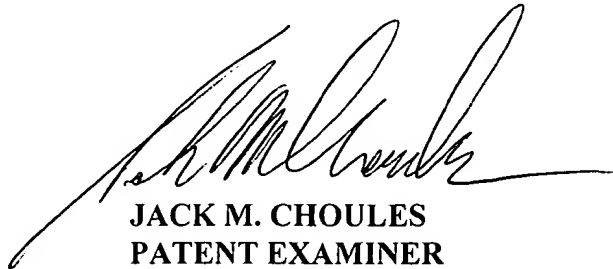
(703) 305-9731 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner
should be directed to Jack Choules whose telephone number is (703) 305-9840. The examiner
can normally be reached on Monday-Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Thomas G. Black can be reached at (703) 305-9707.

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703) 305-9600.



JACK M. CHOULES
PATENT EXAMINER
ART UNIT 2771

JMC
June 29, 1998